



Atty. Dkt. No. 034536-0407

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tod R. SMEAL et al.
Title: GEF-H1B: BIOMARKERS, COMPLEXES ASSAYS
AND THERAPEUTIC USES THEREOF
Appl. No.: 10/611,671
Filing Date: 7/2/2003
Patent No.: 7,439,329 B2
Grant Date: October 21, 2008
Examiner: XIAOZHEN XIE
Art Unit: 1646
Confirmation Number: 5378

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on 10/21/2008 as U.S. Patent No. 7,439,329 B2.

The Patent Office determined that the patent was entitled to 566 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to **785** days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

There were no circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	902 days
(b) Total Applicant delay:	117 days
Final PTA Determination:	785 days


Applicants therefore respectfully request that the patent be accorded 785 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Respectfully submitted,

By 

Michele M. Simkin
Attorney for Applicant
Registration No. 34,717

Date: December 19, 2008

FOLEY & LARDNER LLP

Customer Number: 22428

Telephone: (202) 672-5538

Facsimile: (202) 672-5399



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Docket Number: 034536-0407

Application Number: 10/611671

Patent Number: 7439329

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	07/02/2003	0		
	14 month From Application date	09/02/2004	428		
Edit Delete	Restriction Requirement	06/27/2006	1,091	663	
	3 Year Period Starts	07/02/2006	1,096		
Edit Delete	Restriction Requirement Response Received at PTO	08/25/2006	1,150		
Edit Delete	Non-Final Office Action	11/06/2006	1,223		
Edit Delete	Request For Continued Examination	02/06/2007	1,315		
	3 Year Period Stopped	02/06/2007	1,315	219	
Edit Delete	Non-Final Office Action	05/01/2007	1,399		
	Non-Final Office Action + 3 months	08/01/2007	1,491		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	09/04/2007	1,525		34
Edit Delete	IDS under 1.704(c)(8) filed at PTO	11/26/2007	1,608		83
	Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo	01/04/2008	1,647		
Edit Delete	Non-Final Office Action	01/24/2008	1,667	20	
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	04/23/2008	1,757		
Edit Delete	Notice of Allowance	08/01/2008	1,857		
Edit Delete	Issue Fee Paid	09/11/2008	1,898		
Edit Delete	Patent Grant Date	10/21/2008	1,938		
			Totals:	902	117
			PTA:	785	

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